

REMARKS

This paper is filed in response to the office action mailed on October 3, 2003. Claims 4 and 5 have been canceled; claims 1, 3, 7, 12 and 15 have been amended; claims 1-3 and 6-17 are pending..

In the office action, the drawings are objected to and the Request for Approval of Drawing Changes has been submitted herewith to traverse this objection.

The office action also rejects claims 3-5 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. In response, claims 4 and 5 have been canceled and claim 3 has been amended to make it clear that in the first read mode, the data in the first, second and third backup registers is simultaneously updated with the data stored in the first, third and fifth registers as recited in claims 1 and 2. Further, claim 3 has been amended to make it clear that in the second read mode, the data in the first, second and third backup registers is not simultaneously updated with the data in the first, third and fifth registers as recited in claims 1-2. Thus, claim 3 covers two different read modes, a first read mode where the backup registers are simultaneously updated with their corresponding data registers and a second read mode where the backup registers are not simultaneously updated with their corresponding data registers. Applicant respectfully submits that claim 3 as amended is not indefinite and is in full compliance with 35 U.S.C. § 112, second paragraph and therefore this rejection is improper and should be withdrawn.

With respect to the objections based upon the prior art, the office action rejects claims 12-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,526,296 ("Nakahara"). Applicant respectfully submits that this rejection is improper for the following reasons.

Under MPEP § 2131,

"[t]o anticipate a claim, the reference must teach every element of the claim. 'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.'"

Citing, Verdegaa Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully submits that Nakahara cannot serve as an anticipating reference for the following reasons. Claim 12 recites two masking circuits for a

circular buffer whereby the first masking circuit receives two memory words from the circular buffer including the data to be read and excluding a rightmost bit of the data from the circular buffer that is not part of the data to be read. Claim 12 requires that the data to be read by the first masking circuit excludes at least the rightmost bit. Claim 12 also requires the first masking circuit to output a subset of unwanted data which includes at a minimum the rightmost bit. Claim 12 also requires the second masking circuit to mask or receive the unwanted data output from the first masking circuit.

Applicant respectfully submits that these features are not found in Nakahara and therefore the anticipation rejection of claims 12-14 should be withdrawn.

Specifically, Nakahara discloses a bit stream apparatus that stores a first read point and a length of bit stream data that does not store the number of ignored bits of the bit stream data. Nakahara does not teach or suggest the way to directly access the number of bits of unwanted or ignored data. In contrast, claim 12 requires a number of unwanted bits to be stored by the second masking circuit. Support for this amendment appears in the specification at page 6, lines 12-14. Because this storing of the number of unwanted bits is not taught or suggested by Nakahara, Nakahara cannot serve as an anticipating reference and the anticipation rejection of claims 12-14 is therefore improper and should be withdrawn.

Next, the office action rejects claims 15-17 under 35 U.S.C. § 103 as being unpatentable over Nakahara. Applicants respectfully submit that this rejection is improper and should be withdrawn for the following reasons.

At the outset, under MPEP § 2142,

"[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (Emphasis Added).

Applicant respectfully submits that independent claim 15 is allowable over Nakahara for the same reason that independent claim 12 is allowable over Nakahara. Nakahara does not teach or suggest a system whereby the number of unwanted bits is stored. The subtractor or ALU disclosed by Nakahara does not disclose this function. Because at least this claim limitation is not taught or suggested by Nakahara, the obviousness rejection of claims 15-17 is improper and should be withdrawn.

Finally, the office action rejects claims 1-11 under 35 U.S.C. § 103 as being unpatentable over Nakahara in view of U.S. Patent No. 6,065,107 ("Luick"). In response, applicant presents the following remarks.

Nakahara is deficient as a base reference for the reasons set forth above. Nakahara does not teach or suggest the storing of the number of unwanted bits from the bit stream data. With respect to amended claim 1, Nakahara does not teach or suggest anything remotely similar to the third register for storing data indicative of the number of unwanted or ignored bits or a backup register for storing the data in the third register. Thus, Nakahara is clearly deficient as a base reference. In an attempt to supplement the deficiencies of Nakahara, the Patent Office relies upon Luick. However, Luick merely teaches the concept of applying exceptions in a latch feedback loop. Luick does not teach or suggest a separate register for storing the number of unwanted bits and a backup register for that register. Thus, no combination of Nakahara and Luick teaches or suggests all of the features or limitations of amended claim 1 and therefore applicant respectfully submits that the rejection does not meet the requirements of MPEP § 2142.

Applicant respectfully submits that in view of the above amendments and remarks, that this application is in a condition for allowance and an early action so indicating is respectfully requested.

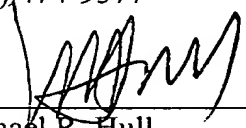
The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-9577

December 31, 2003

By:



Michael R. Hull
Reg. No. 35,902